

REMARKS

Favorable reconsideration of this application is requested in view of the following remarks. Claims 1-4 and 7-20 remain actively pending in the case. No new matter has been added. Reconsideration of the claim is respectfully requested.

On page 3 of the Office Action, claims 1 and 18 (and their dependent claims) were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

Applicants respectfully disagree with Examiner. Applicants submit that information regarding the position of said subject obtained from said digital image and used for producing said cut image product is supported by Applicants' specification. For example, with respect to Figure 5 and associated text on pages 6-7, a digital image file to obtain a subject is selected. *See Fig. 5, step 82.* Algorithms are used to outline the subject. *See Fig. 5, step 88.* A vector analysis is performed on the subject outline and a resulting outline vector data file is stored on a server 16. *See Fig. 5, steps 98 and 100.* The outline vector data file is then sent to the cutter to cut the digital print. *See Fig. 5, step 112 and page 7 line 31 - page 8, line 1.*

Thus, information regarding the position of said subject is obtained from said digital image and is used for producing said cut image product. Accordingly, Applicants submit that at least claims 1 and 18 contain subject matter that is described in the specification and are in condition for allowance. Therefore, in view of the above remarks, Applicants respectfully request that Examiner withdraw the rejections.

In paragraph 5 on page 4 of the Office Action, claims 1-4, 7-9 and 16-18 were rejected under 35 USC § 103(a) as being unpatentable over Kinjo (US 6,519,046) and Miyazaki et al. (US 6,619,166) in view of Matsumura et al. (US 5,949,431). In paragraph 6 on page 10 of the Office Action, dependent claims 14 and 15 were rejected under 35 USC § 103(a) as being unpatentable over Kinjo, Matsumura and Miyazaki as applied to claim 1, and further in view of Fernandez et al. (US 2002/0092215). In paragraph 7 on page 12 of the Office Action, claim 12 was rejected under 35 USC § 103(a) as being unpatentable over Kinjo,

Matsumura and Miyazaki as applied to claims 1 and 9, and further in view of Buck (US 5,851,614). In paragraph 8 on page 12 of the Office Action, claim 11 was rejected under 35 USC § 103(a) as being unpatentable over Kinjo, Matsumura and Miyazaki as applied to claims 1 and 9, and further in view of Peck (US 5,899,010). In paragraph 9 on page 13 of the Office Action, claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Kinjo, Matsumura and Miyazaki as applied to claims 1 and 9, and further in view of Ogikubo (US 5,994,990). In paragraph 10 on page 14 of the Office Action, claim 13 was rejected under 35 USC § 103(a) as being unpatentable over Kinjo, Matsumura and Miyazaki as applied to claim 1, and further in view of Poole (US 5,962,368). In paragraph 11 on page 15 of the Office Action, claims 19 and 20 were rejected under 35 USC § 103(a) as being unpatentable over Kinjo and Miyazaki. Applicants respectfully traverse the rejections.

Firstly, as discussed above with respect to the written description requirement, the cited references fail to teach or suggest that information regarding the position of said subject is obtained from said digital image and is used for producing said cut image product.

Secondly, as admitted by the Office Action, Kinjo fails to teach producing said cut image product from said sheet of media as recited in claim 1.

Miyazaki fails to remedy the deficiencies of Kinjo as Miyazaki fails to teach or suggest producing said cut image product from said sheet of media incorporating said removed subject. Miyazaki does not automatically differentiate the selected subject from the background of said digital image. Accordingly, Miyazaki cannot possibly produce a cut image product incorporating said automatically differentiated subject. Rather, Miyazaki merely discloses a printing apparatus with a cutter used to cut images that are identified in a desired size and layout. In particular, a cutting pattern is selected from a plurality of predetermined cutting patterns. Col. 2, lines 19-20. Moreover, in Miyazaki, layout and image shapes made available to the user. In operation, the first step is the selection of an image illustrated by 10A in Figure 16. Then a layout and punching shape is selected. *See* Fig. 16, 10B and 10C; Col. 10, lines 62-65. Template images such as those set forth in Figures 20A, 20B and 20C are used in conjunction with images to produce composite images as set forth in

Figures 21A, 21B and 21C respectively. These images are printed in a pattern in accordance with a selected layout. Col. 10, line 58 – Col. 12, line 23.

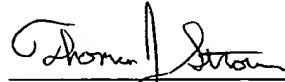
Matsumura fails to remedy the deficiencies of Kinjo and Miyazaki as Matsumura fails to teach or suggest producing said cut image product from said sheet of media incorporating said removed subject. Also, Matsumura does not automatically differentiate the selected subject from the background of said digital image. Rather, Matsumura discloses creating a one-page image layout using masked images and priority levels for the masked images. Col. 7, line 50 – Col. 8, line 6.

Thus, in view of the above remarks, Applicants' invention is patentable over the cited references. It is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of Fernandez, Buck, Peck, Ogikubo, Poole as applied to the above prior art references is moot, inasmuch as the combination of Kinjo, Miyazaki, Matsumura, Fernandez, Buck, Peck, Ogikubo and Poole still lacks any teaching, disclosure, or suggestion concerning Applicants' invention as previously discussed.

Therefore, in view of the above remarks, Applicants' independent claim 1 is patentable over the cited references. Rejected independent claims 18-20 recite one or more features generally similar to those of claim 1 discussed above. Accordingly, for similar reasons as discussed above, independent claims 18-20 are believed to be patentable over the cited references. Because claims 2-4 and 7-17 depend from claim 1 and include the features recited in the independent claim, Applicants respectfully submit that claims 2-4 and 7-17 are also patentably distinct over the cited references. Nevertheless, Applicants are not conceding the correctness of the Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Thomas J. Strouse", written over a horizontal line.

Attorney for Applicant(s)
Registration No. 53,950

Thomas J. Strouse/phw
Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.